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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/559,115

Filing Date: June 08, 2006

Appellant(s): MANI ET AL.

Edward A. Squillante, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3-19-10 appealing from the Office action mailed 10-21-09.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:
Claims 1-9 are pending.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

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subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

5,968,528 DECKNER 1999

Kazuhisa et al., Japanese Publication (2003-055184), 2-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Osumi et al Japanese publication (JP 20033055184) in view of Deckner et al (US 5,968,528) for reasons of record and restated below:

The claims are drawn to a skin lightening composition, comprising 0.1-50% by weight of extracts of plants from the genera Symplocos and Rubia; the extract of Symplocos being selected from Symplocos racemosa, Symplocos paniculata, Symplocos cochinchinensis, or mixtures thereof; the extract of Rubia being Rubia cordifolia.

The reference of Osumi et al beneficially teaches a skin care composition with bleaching (i.e. whitening) action comprising an extract from the plant Symplocos racemosa. The extracts from Symplocos can be extracted from the bark or other parts of the plant. The extracts from Symplocos have excellent active oxygen scavenging activity, collagenase inhibitory and tyrosinase inhibitory actions. The skin care composition has excellent aging preventing actions and good stability (see, e.g., abstract and pages 1-3).

The reference of Deckner et al. beneficially teaches a skin care composition to treat the signs of aging. The composition comprises vitamin B3, especially niacinamide, and can also comprise other dermatological active ingredients such as extracts from the plants of the genus Rubia, particularly Rubia Cordifolia, sunscreen agents such as 2-ethyl hexyl methoxycinnamate, skin lightening agents, and glycyrrhiza (licorice) (see, e.g., col 28, lines 14-44; and col 29, lines 57-6; and col 31,lines 41-60).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to combine the instant ingredients for their known benefit since each is well known in the art for the same purpose (e.g., in skin compositions for skin conditioning) and for the following reasons. It is well known that it is prima facie

obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. In re Kerkhoven, 626 F.2d 846, 850, 205 U.S.P.Q. 1069 (CCPA 1980), In re Sussman, 1943 C.D. 518; In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

This rejection is based on the well established proposition of patent law that no invention resides in combining old ingredients of known properties where the results obtained thereby are no more than the additive effect of the ingredients. With respect to the percent by weight of the claimed ingredients in the instant composition is viewed as judicious selection and adjustments of particular working conditions that are within the purview of one skilled in the art.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

(10) Response to Argument

The appellant argues that Osumi et al. merely discloses that an extract from the plant of the genus *Symplocos* may be used in a skin preparation that exhibits anti-aging benefits and bleaching actions. The appellant argues that the reference fails in every way to specifically describe all of the specific *Symplocos* extracts of the claimed invention. The appellant argues that the reference is deficient in that it fails in every way to describe the extract of *Rubia* used in conjunction with *Symplocos* extract.

In response, the examiner has rejected claims 1-9 under USC 103, not USC 102. Under a USC 103 obviousness rejection, the Osumi et al. reference is not required to teach each and every claimed limitation when the rejection relies on a combination of references. The examiner is not required to reject all of the species of *Symplocos* because claim 1 is in an alternative format (i.e. Markush group) and therefore only requires the rejection of at least one species to satisfy the instant claim.

Appellant argues that the Deckner et al. reference does not cure the deficiencies of the primary reference which merely mentions that an extract in the genus *Rubia cordifolia* can be used as a natural anti-inflammatory agent. Appellant argues that there is no teaching whatsoever or suggestion that the extract of *Rubia* will yield excellent skin lightening benefits when used in conjunction with the extract *Symplocos*. Appellant argues that there is no teaching whatsoever that even remotely suggests that such extracts in combination will yield a stable composition. Appellant argues that there is no teaching to suggest unexpected synergistic benefits that the inventors observed when

using a mixture of the each extract and directs the examiner's attention to Table 1 in the specification.

In response, the examiner wishes to emphasize that the claims are drawn to a composition (i.e. product). In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use of a composition does not patentably distinguish the composition. Especially given that it is well known in the art to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose to form a third composition. *In re Kerkhoven*, 626 F.2d 846, 850, 205 U.S.P.Q. 1069 (CCPA 1980), *In re Sussman*, 1943 C.D. 518; *In re Pinten*, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re Susi*, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); *In re Crockett*, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

The Osami et al. reference beneficially teaches a skin care composition with skin lightening properties that include extracts from *Symplocos racemosa* having excellent oxygen scavenging activity that conditions the skin by fighting signs of aging. The Deckner et al. reference beneficially teaches a skin care composition useful for skin conditioning activities that include extracts from *Rubia Cordifolia*. The skin conditioning activities include oxygen scavenging activity that fights signs of aging in the skin. One of ordinary skill in the art would recognize that the skin care ingredients disclosed in both of the cited references are useful for the same purpose and thus would be motivated to combine such ingredients.

The fact that applicant has recognized another advantage for combining the two compositions (i.e. skin lighting properties) which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Although the cited references do not specifically point out that Rubia and Symplocos are useful for skin lightening purposes, both references comprise skin lightening ingredients in their skin care compositions.

With respect to Appellant's claim to synergy, the examiner has reviewed Table 1 and the results are inconclusive. Synergy is described in the M.P.E.P as the sum of the two compositions to be greater than the sum of each of the effects taken separately. Table 1 demonstrates that composition A (i.e. Rubia) does not reduce the amount of melanin because it exhibits a melanin content at 131.5% of control (which had no exposure to the tested compositions). Table 1 demonstrates that composition B (i.e. Symplocos) reduces the amount of melanin formed to 89.1% of control. Table 1 demonstrates that both compositions A + B reduce melanin to 95.1% of control. This is confusing because if there was synergy both compositions together should have a greater effect than each composition individually. Instead, the results are inconclusive because 95.1% of control (i.e. combination of A + B) is actually a lower effect on melanin content than 89.1% demonstrated by composition B alone. Regarding the Table 2 data, Table 2 shows that Rubia alone had a slight effect on uptake of melanin at 94.6% of control (which had no exposure to the tested compositions) and Symplocos alone had more of an effect on uptake of melanin at 89.78% of control. However,

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together, Rubia with Symplocos had only a slightly greater effect on melanin uptake at 89.6% of control, only a 0.18% greater effect than Symplocos alone, which is not even an additive effect, let alone a synergistic effect on melanin uptake. Therefore, the data cited by the appellants does not support the appellant's arguments of unexpected results/synergy.

With respect to appellant's comment that the examiner has not previously raised any issues regarding the range of 0.1-50% being indefinite is not true *per se*. The examiner did mention the amounts not being clear in the arguments of the final rejection. However, the percent ranges of the extracts are broad (0.1-50%) and would appear to be judicious selection. It is within the skill of one in the art through routine experimentation to find ranges that would work. Merely selecting proportions and ranges is not patentable absent a showing of criticality. *In re Becket*, 33 U.S.P.Q. 33 (C.C.P.A 1937). *In re Russell*, 439 F.2d 1228, 169 U.S.P.Q 426 (C.C.P.A 1971). With respect to applicant's argument that the prior art compositions will not form a stable composition is not a limitation required by the instant claims.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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